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No. 88-1099

IN THE

Supreme Court of the United States

OCTOBER TERM, 1988

BV ENGINEERING,

Petitioner,

v.

UNIVERSITY OF CALIFORNIA, LOS ANGELES, (THE REGENTS OF THE UNIVERSITY OF CALIFORNIA),

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* ON BEHALF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PETITIONER TOGETHER WITH BRIEF *AMICUS CURIAE*

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On Petition For A Writ Of Certiorari To The United States Court of Appeals For The Ninth Circuit

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MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* ON BEHALF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PETITIONER

The American Intellectual Property Law Association (AIPLA) hereby respectfully moves this Court for leave to file a brief in this case as *amicus curiae* in support of Petitioner.* The consent of the attorneys

* AIPLA has filed a virtually identical motion and brief in *Richard Anderson Photography v. Radford University*, No. 88-651, now pending before the Court, which presents the identical issues as are presented here.

for Petitioner has been obtained for the filing of a brief *amicus curiae* by the AIPLA. The consent of the attorneys for the Respondent was requested by the AIPLA but was refused.

The AIPLA constitutes a national bar association of more than 5,600 members, including attorneys whose interest and practice lie in the areas of patent, copyright, trademark, trade secret, and other intellectual property law. Because of the unique expertise of its members and its nonpartisan status, the AIPLA believes that its views on the issues raised by this case, and the implications of those issues, would be of aid to this Court.

Certain issues of national public importance which are raised by this case deeply concern the AIPLA. The decision below jeopardizes the right of copyright owners generally and also the rights of owners of other forms of intellectual property. The decision below seems likely to allow the states free rein to pirate the copyrights and patents they use, as the owners of such intellectual property would be left without a forum in which redress for such piracy could be had. Thus, this case presents a question which has implications far beyond the particular facts now before this Court.

Because the AIPLA believes the case below was wrongly decided and because the case involves an important question which affects owners of intellectual property generally, the AIPLA wishes to join Petitioner in urging this Court to grant a writ of certiorari and review this case on the merits. Consequently, the AIPLA respectfully requests that this Court grant the AIPLA leave to file its brief *amicus curiae* in the form submitted with this motion.

Respectfully submitted,

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BRIEF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

This *amicus curiae* brief is submitted in support of the petition for a writ of certiorari. Petitioner has consented to the filing of this brief, and respondent has refused such consent. A motion for leave to file this brief has been filed.

INTEREST OF THE *AMICUS*

The American Intellectual Property Law Association (AIPLA) is a national bar association of more than 5,600 members. Its members are attorneys whose interest and practice lie in the areas of patent, copyright, trademark, trade secret, and other intellectual property law.[1] AIPLA's members include attorneys in private practice and those employed by corporations, universities, and government. Unlike many other areas of practice, in which separate and distinct plaintiffs' and defendants' bars exist, most, if not all, intellectual property law attorneys represent both plaintiffs and defendants.

AIPLA is deeply concerned about certain issues of public importance in this case. Specifically, if allowed to stand, the decision below would jeopardize the rights of copyright owners generally and also the rights of owners of other forms of intellectual property, including numerous patents of enormous value that are widely used by state governmental bodies. Simply put, if the decision below stands, states could pirate the copyrights and patents they use—from textbooks to road-paving machines—with impunity.

Because we believe the case below was wrongly decided, because it involves an important question of federal law which has not been, but should be, settled by this Court, and because the interests of intellectual property owners represented by our members would be directly and adversely affected if the decision below is allowed to stand, we join petitioner in urging

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[1] Prior to 1984, AIPLA was known as the American Patent Law Association.

this Court to grant a writ of certiorari and review this case on the merits.

ARGUMENT

THE EXCLUSIVE JURISDICTION OF THE FEDERAL COURTS OVER COPYRIGHT AND PATENT MATTERS PRECLUDES APPLICATION OF STATE SOVEREIGN IMMUNITY UNDER THE ELEVENTH AMENDMENT

This case presents an important issue not presented in any Eleventh Amendment case previously decided by this Court: Does sovereign immunity under the Eleventh Amendment immunize a state which violates a federal right when: a) there is *exclusive* federal jurisdiction over that right; and b) such immunity would mean that *no* meaningful redress would be available to an aggrieved party for violations of that right in *any* court, state or federal?

The Constitution grants only to Congress, and not to the states, the power to enact uniform copyright and patent statutes. U.S. Const., Art. I, Sec. 8, Cl. 8. Those statutes, and the supremacy doctrine, have made copyright and patent rights exclusively federal in nature. 17 U.S.C. §301(a) (pre-empting state statutory or common law copyright); *Sears, Roebuck & Co. v. Stiffel & Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

Congress, in turn, has granted the federal courts exclusive jurisdiction over copyright and patent cases arising under those statutes. 28 U.S.C. §1338(a).[2]

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[2] That statute provides:

> The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents,

This Court's prior considerations of Eleventh Amendment immunity involved cases in which an aggrieved party, if deprived of the opportunity for redress in the federal courts, could nevertheless find such redress in state court.[3] Indeed, one of the basic rationales supporting Eleventh Amendment immunity has been that, the state courts being available, the plaintiff, although deprived of access to the federal courts, will not be completely without a forum. *Ex Parte Young*, 209 U.S. 123, 176 (1907) (Harlan, J., dissenting); *Employees v. Missouri Public Health Dept.*, 411 U.S. 279, 287 (majority opinion) and 298 (Marshall, J., concurring in result) (1973); *Atascadero State Hospital v. Scanlon*, 473 U.S. 234, 239-240, n.2 (1985).

But application of Eleventh Amendment immunity, combined with exclusive federal jurisdiction, would deprive copyright and patent owners of any forum to assert their rights. As a result, the Constitutionally-based rights of copyright and patent protection would

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plant variety protection, copyright, and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

[3] The only case we find in which exclusive federal jurisdiction has been urged as a factor to deny Eleventh Amendment immunity is pending before this Court: *Commonwealth of Pennsylvania v. Union Gas Co.*, No. 87-1241 (argued October 31, 1988). But even there, as was made clear at oral argument, the state's immunity was, in a sense, only partial: the state remained liable to the United States notwithstanding its immunity to suit by private parties Here, and in all copyright and patent cases instituted by a private party, the immunity, if applicable, would be total, for only the private party—the copyright or patent owner and not the Government—is authorized by statute to bring suit. 17 U.S.C. §501(b); 35 U.S.C. §281.

exist only in theory: there would be no effective remedy for acts of infringement by the states, and the specific, exclusive federal jurisdiction of 28 U.S.C. §1338(a) would be meaningless in such cases. Copyright and patent owners could not be made whole by damage awards for state piracy of their property, and, without that remedy, states would not be motivated to comply with the law and obtain licenses for their uses of that property.

It is no answer to suggest that copyright or patent owners could obtain equivalent redress under other state statutory or common law.[4] The Copyright Act specifically preempts such equivalent state statutory or common law. 17 U.S.C. § 301(a). And the supremacy doctrine does likewise in both the copyright and patent areas. *Sears, Roebuck & Co. v. Stiffel & Co., supra; Compco Corp. v. Day-Brite Lighting Inc., supra.*

The Constitution itself states that the purpose behind the federal copyright and patent laws is to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. Const., Art. I., Sec. 8, Cl. 8. The decision below, under the guise of the Eleventh Amendment, allows the states to violate these federally-protected rights—it gives them a free, compulsory license, not intended by Congress or the

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[4] Such a suggestion was made by respondent Radford University in *Richard Anderson Photography v. Radford University*, No. 88-651, Br. in Opp. at 5-6. (That case, for which a petition for certiorari is pending, presents the identical issues presented here.)

Constitution. It thus conflicts with the Constitutional mandate of securing *exclusive*, and exclusively *federal*, rights to authors and inventors.

We respectfully urge this Court to review the decision below, for the reasons set forth herein and those advanced by petitioner, and to consider the important and previously unconsidered question whether sovereign immunity applies when the right at issue is violated by a state but is exclusively within federal jurisdiction.

CONCLUSION

This Court should grant petitioner's request for a writ of certiorari to review the Ninth Circuit's decision.

Respectfully submitted,

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